

II. REMARKS

A. Status of the Claims

Claim 1 has been amended without prejudice to incorporate features of claim 8, which was indicated as allowable.

Claim 27 has been amended without prejudice to incorporate features of claim 34, which was indicated as allowable.

Claims 4, 5, 14, 18, 25, 35, 39, 40, 47-50, and 53-56 have been amended without prejudice. Support for the amendments can be found throughout the specification and in the original claims. In particular, support for the amendments to claims 39, 47, 49, 53, and 55 can be found, e.g., on page 6, last paragraph, to page 8, last paragraph, of the specification as filed.

Claims 8, 15-17, 34, 36, 41-46, and 51-52 have been cancelled without prejudice.

Claims 1-7, 9-14, 18-33, 35, 37-40, 47-50, and 53-56 are pending.

Applicants respectfully submit that no new matter has been added by virtue of these amendments.

B. Claim Objections

Claims 39, 41, 43, 45, 47, 49, 51, 53, and 55 have been objected to under 37 CFR 1.75(c), "as being of improper dependent form ..." *Office Action, page 2.*

Claims 41, 43, 45, and 51 have been cancelled without prejudice.

Claims 39, 47, 49, 53 and 55 have been amended without prejudice to further limit the respective independent claims.

Withdrawal of the objection is respectfully requested.

C. Claim Rejections- 35 U.S.C. § 112

Claims 39-56 were rejected under 35 U.S.C. 112, second paragraph. The Examiner stated that the phrase “wherein the active agent is selected from the group consisting of hydrocodone, a non-opioid drug, their mixtures” renders the claims confusing and unclear.” *Office Action, page 3*. The Examiner further stated that “[i]t appears that Applicant intended to provide limitations drawn to “further comprising a non-opioid drug ...”

Claims 39, 41, 43, 45, 47, 49, 51, and 53 have been amended without prejudice to recite that “the dosage form further comprises a non-opioid drug.”

Withdrawal of the rejection is respectfully requested.

D. Claim Rejections- 35 U.S.C. § 103

Claims 1-7, 9-17 and 39-48 were rejected under 35 U.S.C. § 103(a) over WO 99/32120 to Palermo (“the Palermo publication”).

Independent claim 1 has been amended without prejudice to incorporate features of claim 8, which was indicated as allowable.

Claims 2-7, 9-14, 39, and 40 depend from claim 1, and therefore should also be allowable. *See, e.g., In re Fine, 837 F.2d 1071 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. Hartness Int’l, Inc. v. Simplimatic Eng’g Co., 819 F.2d 1100, 1108, 2*

USPQ2d 1826, 1831 (Fed.Cir.1987); In re Abele, 684 F.2d 902, 910, 214 USPQ 682, 689 (CCPA 1982); see also In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed.Cir.1983)”).

Claims 47 and 48 depend from claim 18, which was indicated as allowable, and therefore should also be allowable. *See, e.g., In re Fine, 837 F.2d 1071 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. Hartness Int’l, Inc. v. Simplimatic Eng’g Co., 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed.Cir.1987); In re Abele, 684 F.2d 902, 910, 214 USPQ 682, 689 (CCPA 1982); see also In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed.Cir.1983)”).*

Claims 15-17 and 41-46 have been cancelled without prejudice.

Withdrawal of the rejection is respectfully requested.

Claims 27-33, 35, 36 and 49-52 were rejected under 35 U.S.C. § 103(a) over the Palermo publication in view of U.S. Patent No. 4,844,907 to Elger et al. (“The Elger patent”).

Independent claim 27 has been amended without prejudice to incorporate features of claim 34, which was indicated as allowable.

Claims 28-33, 35, 49, and 50 depend from claim 27, and therefore should be allowable. *See, e.g., In re Fine, 837 F.2d 1071 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. Hartness Int’l, Inc. v. Simplimatic Eng’g Co., 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed.Cir.1987); In re Abele, 684 F.2d 902, 910, 214 USPQ 682, 689 (CCPA 1982); see also In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed.Cir.1983)”).*

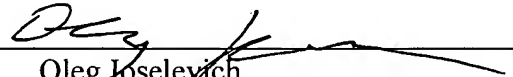
Claims 36 and 51-52 have been cancelled without prejudice.

Withdrawal of the rejection is respectfully requested.

III. CONCLUSION

An early and favorable action on the merits is earnestly solicited. The Examiner is respectfully requested to contact the undersigned at the telephone number provided below in the event that a telephonic interview will advance the prosecution of the application.

Respectfully submitted,
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